

**REMARKS**

Claims 1, 7, 8, 10, 11, 18, 19, and 21-27 remain pending in this application and were rejected in the last Office action. The Applicant respectfully traverses those rejections, for the reasons set forth below.

Method Claims 25-27 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written-description requirement. Those claims define a method including “positioning the non-billing information within the customized communication at a location relative to the location of the billing information...that varies from locations of the non-billing information relative to the billing information in at least one prior customized communication to the customer, whereby the billing information is not always in the same area of a customized communications”. The rejection states that paragraph 0007 in the Applicant’s specification is the only support for that element of Claim 1 and asserts that to accomplish that element, the invention must store information on where information was placed in at least one prior customized communication to the customer. Finding nothing in the specification indicating that the disclosed system stores or saves a layout as previously presented to the user, the Examiner concludes that there is no way for the system to be sure that a current bill varies from a prior bill, and holds that the Applicant was not in possession of such a system at the time of the present invention.

The Applicant agrees that a way to implement the embodiment of Claim 25 would be to store information on the location of the billing information in prior customized communications for the customer. However, the Applicant submits that an alternative approach would be to vary the location of the billing information, relative to the non-billing information, in a random manner when preparing each bill. This alternative approach would not require storing

information about the location of the billing information in at least one prior communication, unlike the implementation suggested by the Examiner. Furthermore, given the number of items of non-billing information disclosed as potential communications with customers (please see paragraph 0025 and 0041, for example, and Figure 3) it is highly likely that a bill utilizing a hypothetical random placement of billing information would position the billing information in locations that vary from bill to bill.

Accordingly, the Applicant respectfully submits that one of ordinary skill in the art of designing and implementing computer-generated billing systems would find sufficient written description in the present application to practice the method of Claims 25-27. For those reasons, the Applicant respectfully traverses the rejection of those claims under the first paragraph of 35 USC § 112.

Claims 1, 7, 8, 10, 11, 18, 19, and 21-27 are rejected as being unpatentable over *Munsil* (US 5,761,650) in view of newly-cited *Nelsen*. The Applicant respectfully traverses that rejection.

The rejection recognizes that *Munsil* does not teach the following elements of the claimed method:

- (a) Positioning the non-billing information between a customer identifier located at the beginning of a communication and billing amount located at the end of the communication; and
- (b) wherein the customer can opt not to receive any non-billing information.

Considering the first such teaching (a) missing from *Munsil*, the Examiner notes the Applicant's disclosure that not always locating the billing information in the same location may induce a customer to read non-billing information, but concludes that such dynamic location of

non-billing information is just as likely not to induce a customer to read that non-billing information. The Examiner finds support for that conclusion in the Applicant's specification. The Applicant traverses both that interpretation of the specification and the Examiner's conclusion based thereon.

Embodiments of the present invention relate to communicating billing and non-billing information to customers in a combined matter [0001]. One disclosed embodiment of the invention comprises combining non-billing information with a customer's billing information, using a set of classifications that are correlated to customer traits [0005]. The vendor defines a set of classifications correlated to customer traits, assigns those classifications to its customers, and selects items of non-billing information and records that information in a database [0005]. One object of the disclosed embodiment is to customize the information received by a particular customer, thereby tailoring that information and its presentation [0006]. In one disclosed embodiment of the invention, as the Examiner notes, the billing information is not always located in the same area of the newsletter, which "may induce a customer to read non-billing information while searching for the billing information, particularly since the information is tailored to the customer" [0007].

Given the foregoing excerpts from the Applicant's disclosure, it should be evident that the Applicant is indeed seeking to induce customers to read non-billing information presented on bills to those customers. A clear and unmistakable purpose of the Applicant's specification pertains to communicating both billing and non-billing information to customers, and to inducing a customer to read the non-billing information. To state, as the Examiner does in the sentence bridging pages 5 and 6 of the last Office action, that the Applicant's placement of non-billing

information “holds no functional importance” is unsupportable in the face of the Applicant’s emphasis on inducing a customer to read the non-billing information.

The Applicant likewise traverses the Examiner’s finding that the limitation (placement of non-billing information between a customer identifier at the beginning and a billing amount at the end of the communication) is merely an aesthetic design choice and, as such, would have been an obvious modification of *Munsil* (apparently) to produce that aesthetic design choice. As pointed out above, the method element of positioning the non-billing information, as claimed, is indeed for a particular purpose and is not a mere aesthetic artifice or design choice. Furthermore, the holding in *In re Said* does not support the Examiner’s conclusions. As pointed out by the Applicant in previous remarks and not rebutted by the Examiner, *Said* was decided on an apparatus claim, not a method claim as in the present case. The court in *Said* found “no mechanical function whatever” between the claimed shape and arrangement of a human figure, and the neck of a bottle supporting that figure, in that apparatus claim. The present claims, in contrast with those in *Said*, define a particular method including positioning the non-billing information in a certain manner within the customized communication. That configuration is dictated by the Applicant’s desire to produce a particular function, namely, inducing customers to read the non-billing information. The Applicant respectfully submits that where functional considerations dictate a particular configuration method, the resulting method was not created for the purpose of ornamentation, and the method element must be considered as part of the overall claimed combination in evaluating patentability over the prior art.

Turning to the second teaching (b) missing from *Munsil*, namely, the failure to teach whether the customer can opt not to receive any non-billing information, the rejection cites *Nelsen* as teaching that it is old and well-known in the art for consumers to not want to receive

direct marketing solicitations. The rejection asserts that it would have been obvious to one of ordinary skill to modify the teachings of *Munsil* “to include a list of consumers who wish to not receive non-billing information as taught by *Nelsen*.” The Applicant respectfully traverses that interpretation of *Nelsen* and the rejection based thereon.

*Nelsen* discusses the problems of junk mail and phone solicitation, and suggests ways people can try to have their names removed from such annoying and undesired solicitations. Those ways, according to *Nelsen*, include requesting purveyors of mail advertising to take one’s name off their mailing lists. The *Nelsen* article also mentions the do-not-call list for telemarketers. However, *Nelsen* does not teach or suggest “given the customer an option not to receive any non-billing information...” otherwise combined with the billing information, as in the method of Claim 1. *Nelsen* merely suggests how one might avoid unsolicited junk mail and telemarketing calls, leaving one of ordinary skill unaware of given the customer an option not to receive non-billing information in the context of preparing a customized bill for that customer. That teaching comes only from the present Applicant, not from *Nelsen*.

The Applicant respectfully submits that one of ordinary skill, if considering *Munsil* along with *Nelsen*, would not seek to combine those teaching for any purpose relevant to the claimed embodiments of the present invention. *Munsil* describes a system for producing monthly billing statements, not junk mail or telemarketing calls. *Nelsen*, on the other hand, discusses ways to stop receiving junk mail and telemarketing calls in their entirety. Combining *Nelsen* with *Munsil* would suggest given a customer the option to terminate *Munsil*’s bill production, a result that no service or product provider (although perhaps some of their customers) would accept. For those reasons, the Applicant submits that *Munsil* in view of *Nelsen* would not have suggested, to one of ordinary skill, the method as in Claims 1 et al.

S/N 10/015,250

The foregoing is submitted as a complete response to the Office action identified above. The Applicant respectfully submits that the application is in condition for allowance and solicits a notice to that effect.

Respectfully submitted,

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Date: March 14, 2007

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